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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/305,146

Filing Date: May 04, 1999

Appellant(s): GUYAN ET AL.

John C. Freeman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 13, 2006 appealing from the Office action mailed February 24, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The status of the claims are substantially correct. The rejection of claim 66 under 35 USC 102(e) has been vacated, and this claim is now indicated as allowable. Claims 22 and 41-65 remain rejected under 35 USC 112, first paragraph. Claim 67 remains rejected under 35 USC 102(e).

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

Appellant presented a corrected summary of claimed subject matter in the paper of March 28, 2007. The summary of claimed subject matter in this paper is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The grounds of rejection to be reviewed on appeal are claims 22 and 41-65 under 35 USC 112, first paragraph and claim 67 under 35 USC 102(e).

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner: Claim 66 under 35 USC 102(e).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

U.S. Patent 5,950,169 to Borghesi et al., published September 7, 1999 and filed November 9, 1995.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22 and 41-65 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 22: Claim 22 has been amended to refer to "responsibilities of said system", and includes the negative limitation of "wherein said responsibilities do not include functions

performed by said event processor". This negative limitation is new matter, since it not disclosed or taught in the original specification.

MPEP 2173.05(i) states: "Any negative limitation or exclusionary proviso must have basis in the original disclosure." It further states: "The mere absence of a positive recitation is not a basis for an exclusion."

It has been determined that: (1) The negative limitation of system responsibilities which are defined as not including functions performed by the event processor is a requirement which is not anywhere supported in the original specification; (2) The requirement cannot be supported by the mere absence of the recitation in the specification.

Applicant also does not point to where the feature is disclosed in the specification, which further supports the finding of new matter.

Claims 41-65: Depend on claim 22.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 67 is rejected under 35 U.S.C. 102(e) as being anticipated by Borghesi et al. (U.S. Patent 5,950,169).

Claim 67: The computers (FIGS. 2-3) form the physical architecture of the system that displays insurance claim information (FIGS. 6,7 and 9-15).

FIG.6 illustrates one of the data components residing in the claim file. The claim folder is decomposed into a plurality of levels, such as "assignment", "inspection", "policy", "parties", "statements", "loss" and "repair site". The policy level is at the tab marked "policy". The claim level is at the tab marked "loss". The participant level is at the tab marked "parties". The line level is at the higher level tab marked "totals".

FIG. 6 illustrates the claim folder is displayed via a user interactive interface (a graphical user interface). Any one of the users at the computers (30 or 32 or 34) can interact with the levels of the claim folder to retrieve data of the folder and enter data into the folder. Also see col. 7, lines 40-42 describing simultaneous multi-user interactions.

FIG.3 of Borghesi et al. discloses event processors (30 or 32 or 34) which interact with a data component (a claim folder, FIG. 6). The event processor identifies data events (information about vehicle accidents) by creating data files on vehicle accidents. As seen in FIG. 8E, the event processor can determine a response (i.e. one such response would be to send data) and follow programming steps to identify system components (programs 200-218) where the components can receive data and process the claims using the received data.

(10) Response to Argument

Rejection of claims 22 and 41-65 under 35 USC 112, first paragraph

The amended phrase "wherein said responsibilities do not include functions performed by the event processor" has been indicated as new matter in claim 22. Claims 41-65 depend on claim 22.

In making this rejection, examiner finds no suggestion for this negative limitation within the original disclosure. In rebutting this rejection, applicant asserts that this feature is taught

within two quotations within the specification. The first quotation is recited in appellant's brief on page 14 in the last paragraph. To clarify the differences, the quotation itself is reproduced herein and placed next to the quotation indicated as new matter:

- *Appellant's Specification (page 185):* "The event processor does not process any events itself and maintains clear encapsulation of system responsibilities. For example, an event that affects claims data is processed by the claim component".
- *Indicated as new matter:* "wherein said responsibilities do not include functions performed by the event processor". (The "responsibilities" are system responsibilities).

One difference that becomes immediately clear is that is that quotation from the specification is referring to what the event processor does/does not do whereas the claim is referring to what the system does/does not do. One cannot infer the behavior of the overall system by only describing the behavior of the event processor. This would be analogous to determining the horsepower of an automobile by reading a description of its tires. The tires may very well be an important part of the automobile, but they don't give you any idea of how the automobile performs. Appellant is attempting a similar analogy by inferring the capabilities of an overall system by only describing a subcomponent of that system. Examiner maintains that such lack of support in the specification is the basis for a new matter finding.

A second consideration is that the person of ordinary skill would have to draw multiple sequential inferences in order for the specification to teach the negative limitation. The discussion at page 15, third paragraph of the brief clearly indicates that the person of ordinary skill in the art would have to read a discussion of the prior art on page 2 and as well as a discussion about the event processor on page 185, infer that the two discussions are related and

then infer that the two discussions imply a negative limitation on the responsibilities of the system even though neither quotation describe these responsibilities. By having to draw multiple inferences from multiple sources to reach a negative conclusion, it becomes very clear that the negative limitation is not taught by the appellant's specification, and that appellant is trying to "lace together" strings of positive recitations in order to teach a negative recitation.

A second quotation provided by in the second paragraph of page 15 in the brief.

- *Appellant's specification (page 2):* OOP (object oriented programming) therefore views a computer program as a collection of largely autonomous components, called objects, each of which is responsible for a specific task. This concept of packaging data, structures and procedures together in one component or module is called encapsulation.”
- *Indicated as new matter:* “wherein said responsibilities do not include functions performed by the event processor”. (The “responsibilities” are system responsibilities).

It is first noted that appellant's quotation in the specification derives from the background of the invention, which is describing prior art and is not describing the invention. Secondly, the quotation from the specification has virtually no relationship to the features indicated as new matter. Knowing that encapsulation is a feature of object oriented programming does not mean that you can infer the functions of a system processor, especially when independent claim 22 does not specifically invoke “object oriented programming” as one its features. Thirdly, the quotation is not related to a system or an event processor. It is merely generic discussion of the prior art, disconnected from any discussion of the system to which the claims are drawn. For these reasons, the quotation from the specification does not support the indicated new matter.

Appellant's brief at page 15, last paragraph also discusses appellant's own self-drawn conclusion that the examiner's rejection somehow involves an assumption that would lead to a violation of the encapsulation requirements and result in an inoperable device. Such arguments are clearly erroneous. The issue of new matter has nothing whatsoever to do with the issue of operability. The issue of new matter is a result of a comparison between originally presented material and subsequently presented material. If the subsequently presented material is not fully described or taught by the originally presented material, then the issue of new matter can potentially be raised. This comparison of material has no bearing whatsoever on the separate issue of operability of the invention. The examiner's assertion of new matter derives from a comparison of original material to subsequently presented material and makes no assumptions pertaining to operability.

Appellant's arguments in the second and third paragraphs of page 16 in the brief refer to the question of literal basis in the specification. Examiner has never asserted any requirement that the language of the claim be a verbatim copy of the language of the specification. Since the examiner has never made or even suggested such a requirement, these arguments are moot.

Appellant's arguments at the first paragraph of page 17 of the brief assert that the final office action did not dispute support for the amendment of May 31, 2005 and the subsequent amendment of November 22, 2005 was merely a "re-phrasing" of the amendment of May 31, 2005. This examiner does not believe that any merit exists in debating the meaning of the term "re-phrasing". The record clearly illustrates that new language was added to claim 22 in the amendment of November 22, 2005, that this language had not previously been presented before the examiner, and that it was indicated as new matter when it was presented.

Rejections under 35 USC 102:

The rejection of claim 66 under 35 USC 102 has been vacated. Any arguments addressed to this claim are therefore moot and this claim is indicated by the examiner as allowable.

Appellant's arguments regarding claims 67 appear at pages 20-21 of the brief.

Appellant's first argument is that claim 67 requires that a plurality of users can simultaneously interact with the levels of the claim folders and that Borghesi does not have such a capability. This argument is not correct. Col 7, lines 40-42 of Borghesi describes a local area network in which each computer within the local area network has an interface to access a claim file and all of its tabbed sections. By such an arrangement, simultaneous user interaction can occur with the claim file. There is no factual basis to assuming that only one user can access a claim file if all the users have an interface which can achieve such access. Additionally, the usage of a file server (col. 7, line 6) inherently permits simultaneous access to the claim files. Furthermore, there is no suggestion in Borghesi that all other users are "locked out" when one single user accesses the system. Appellant's conclusion is thus based on an assumption that is not taught within the actual text or drawings of Borghesi.

Appellant also argues that Borghesi does not disclose an event processor that determines a response for an event and identifies a system component. This argument is not correct. FIG.3 of Borghesi et al. discloses event processors (30 or 32 or 34) which interact with a data component (a claim folder, FIG. 6). The event processor identifies data events (information about vehicle accidents) by creating data files on vehicle accidents. As seen in FIG. 8E, the event processor can determine a response (i.e. one such response would be to send data) and follow programming steps to identify system components (programs 200-218) where the components

can receive data and process the claims using the received data. Appellant's arguments only consider the features of FIG. 8E, where appellant asserts that no processor is shown, without considering examiner's repeated assertions that the processor is illustrated in FIG. 3.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Sam Rimell
Primary Examiner
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Conferees:



CHARLES RONES
SUPERVISORY PATENT EXAMINER

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APPEAL CONFERENCE
HELD JULY 19 2007
AGREEMENT TO PROCEED
ON APPEAL


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HOSAIN ALAM
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